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Icebox LLC
1955 West Field Court
Lake Forest, IL 60045

EXAMINER

CHUNG, JASON J

| ART UNIT | PAPER NUMBER |
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2611

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/730,519

Applicant(s)

HARRISON ET AL.

Examiner

Jason J. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-8, 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Gaughan et al. (US Patent # 6,097,383).

Regarding claim 1, Gaughan discloses a web television (column 3, lines 54-55).

Gaughan discloses the web television can communicate with the Internet (column 4, lines 33-43), which meets the limitation on an appliance that only has an Internet mode of operation and a TV mode of operation.

Gaughan discloses the Internet module can execute a web browser (column 9, lines 12-25). Gaughan discloses the web television can communicate with on-line content providers such as by way of Internet (column 3, line 64-column 4, line 6); when the Internet module executes a web browser, it inherently initially starts connecting to a home page, which meets the limitation on the appliance having the capability of connecting the appliance to the Internet and concomitantly displaying a worldwide web home page.

Gaughan discloses the input device can be a keyboard, remote control, trackball, etc. (column 3, lines 54-63). Gaughan discloses the Internet module can execute a web browser (column 9, lines 12-25); the user can go to another web page by typing in a different address related/unrelated to the home page or by clicking on the links (if they exist) of a home page, which meets the limitation on the appliance also having the capability of bringing up and displaying pages which are directly or indirectly linked to the home page.

Gaughan discloses the television video is displayed in the main display (TV mode) of the web television 10 and the Internet video is displayed in a PIP area in the display 12 (column 4, line 44-column 5, line 2). Gaughan discloses a swap may occur between the Internet video and television video between the PIP area and the main area (column 5, lines 2-9); thus the user can control the system to have TV video in the main area (TV mode) being switched with the Internet video so that the TV video is in the PIP area and the Internet video is in the main area (Internet mode), then subsequently return to the original display of TV video in the main area and Internet video in the PIP area, which meets the limitation on the appliance further having the capability, when the appliance is switched out of its Internet mode and then back into the mode, of returning to a web page displayed when the appliance was switched out of the Internet mode.

Regarding claim 2, Gaughan discloses the Internet module can execute a web browser (column 9, lines 12-25). Gaughan discloses the television video is displayed in the main display (TV mode) of the web television 10 and the Internet video is displayed in a PIP area in the display 12 (column 4, line 44-column 5, line 2). Gaughan discloses a swap may occur between the Internet video and television video between the PIP area and the main area (column 5, lines 2-9); thus the user can control the system to have TV video in the main area (TV mode) being switched with the Internet video so that the TV video is in the PIP area and the Internet video is in the main area (Internet mode), then subsequently return to the original display of TV video in the main area and Internet video in the PIP area. The user can then type in the address in the web browser for the home page if the web page is not displayed when the last switch occurs, which meets the limitation on the capability, selectable by a user of the appliance, of returning to the

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worldwide web home page when the appliance is switched from the TV mode to the Internet mode.

Regarding claim 3, Gaughan discloses the television video is displayed in the main display (TV mode) of the web television 10 and the Internet video is displayed in a PIP area in the display 12 (column 4, line 44-column 5, line 2). Gaughan discloses a swap may occur between the Internet video and television video between the PIP area and the main area (column 5, lines 2-9); thus the user can control the system to have TV video in the main area (TV mode) being switched with the Internet video so that the TV video is in the PIP area and the Internet video is in the main area (Internet mode), then subsequently return to the original display of TV video in the main area and Internet video in the PIP area, if switched out of TV mode and then back to the TV mode, will return to the channel which was active when the appliance was switched out of the TV mode.

Regarding claim 4, the limitations in claim 4 have been met in claim 1 rejection. Gaughan discloses the input device is an infrared remote control device (column 3, lines 54-63), which meets the additional limitation on an input device for transmitting data to the integrated unit by signals in a selected part of the electromagnetic spectrum.

Regarding claims 5-6, Gaughan discloses the input device is an infrared remote control device (column 3, lines 54-63), which meets the limitation on the input device generating and transmitting signals in the infrared portion of the electromagnetic spectrum and the input device is a remote control.

Regarding claim 7, Gaughan discloses the input device can be a keyboard (column 3, lines 54-63).

Regarding claim 8, Gaughan discloses the input device can be a remote control (column 3, lines 54-63). Gaughan discloses the television video is displayed in the main display (TV mode) of the web television 10 and the Internet video is displayed in a PIP area in the display 12 and the displays may swap in response from the appropriate command from the remote control device 20 (column 4, line 44-column 5, line 2), which meets the limitation on the input device has exactly two mode selection controls, the controls being a TV control and an Internet control.

Regarding claim 15, Gaughan discloses the web television includes a display 12 (such as a CRT) that is housed in a cabinet (column 3, lines 54-55), which meets the limitation on the integrated unit is of the stand alone type and is constructed to sit on a horizontal surface.

Regarding claim 16, Gaughan discloses the web television includes a display 12 (such as a CRT) that is housed in a cabinet (column 3, lines 54-55), and therefore has the capability of being mounted to an overhead structure as in hospitals and/or hotels, which meets the limitation on the integrated unit has the capability of being mounted to an overhead structure.

Regarding claim 17, Gaughan discloses the video display driver 40, and audio speaker driver 42 (column 4, lines 44-55).

Gaughan discloses the Internet module 34 operatively connected to the video display driver 40 and audio speaker driver 42 (column 4, lines 44-66).

Gaughan discloses the television controller 48 operatively connected to the video display driver 40 and audio speaker driver 42 (column 4, lines 44-66).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9, 11-14, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaughan.

Regarding claims 9, 11, and 12, Gaughan discloses the Internet module can execute a web browser (column 9, lines 12-25). Gaughan fails to disclose the controls in the recited claim. The examiner takes Official Notice that the recited controls are notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gaughan to have the listed controls in order to comply with well known standard functions of web browsing such as change web pages, scroll web pages, moving a cursor about the screen, go to websites, Pause loading, and stop loading.

Regarding claims 13-14, Gaughan discloses the remote control transmits alpha and/or numeric characters to the web television (column 8, lines 18-39), which meets the limitations on the input device has a numerical keypad and a keyboard with keys corresponding to the letters of the alphabet.

Regarding claim 18, Gaughan discloses the Internet module 34 uses Ethernet and phone line. Gaughan discloses the controller is a cable and antenna (column 3, line 65-column 4, line 6), which meets the limitation on cable or antenna. Gaughan fails to disclose USB.

The examiner takes Official Notice that Internet using USB is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to modify Gaughan to have an Internet controller use USB in order to connect a readily available communication standard.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gaughan in view of Pint (US Patent # 5,436,676).

Regarding claim 10, Gaughan discloses TV mode (TV in main area, Internet in PIP) and Internet mode (Internet in main area and TV in PIP) as disclosed in claim 1 rejection.

Gaughan fails to disclose the input device has an options menu displayed being usable in both the TV and Internet modes of operation of the appliance. Pint discloses the program guide is activated when button 47 is pressed (column 3, lines 40-49). Pint discloses the on screen program guide superimposed over most of the regular programming display (column 3, lines 30-39), which meets the limitation on the input device has an options menu displayed being usable in both the TV and Internet modes of operation of the appliance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gaughan to have the input device has an options menu displayed being usable in both the TV and Internet modes of operation of the appliance as taught by Pint in order to let the user know what programming is on other channels without having to switch channels.

4. Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaughan in view of Kitao (US Patent # 6,124,804).

Regarding claim 19, Gaughan discloses a web television (column 3, lines 54-55). Gaughan discloses the web television can communicate with the Internet (column 4, lines 33-43). Gaughan discloses turning the webtv off (column 10, lines 49-56). Gaughan discloses the event is a user instruction to turn on the webtv, a message will be sent to tuner 48 to begin

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displaying video and audio on the webtv (column 10, lines 33-48), which meets the limitation on an appliance which can be turned on and off and has an Internet mode of operation.

Gaughan fails to disclose the appliance coming on in a specified mode if, when the appliance is off, a user activates one of the specified mode controls. Kitao discloses the remote control has a key indicating various functions of electronic devices in addition to a selection key for selecting the electronic device (mode) (column 4, lines 65-column 5, line 6). Kitao discloses the remote control sends the function to the appropriate electronic device selected by the user (column 5, lines 7-12). Kitao discloses a control signal causing the device to power on (column 4, lines 22-31); thus the user selects the appropriate mode (i.e. Internet) and then sends the control signal causing the device to power on in the specified mode, which meets the limitation on the appliance coming on in a specified mode if, when the appliance is off, a user activates one of the specified mode controls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gaughan to have the user turn on the device in a specified mode by pressing the appropriate control if the device is off as taught by Kitao in order to skip the step of turning the appliance on and subsequently selecting the mode, thereby saving time.

Regarding claim 20, Gaughan discloses turning the webtv off (column 10, lines 49-56). Gaughan discloses the event is a user instruction to turn on the webtv, a message will be sent to tuner 48 to begin displaying video and audio on the webtv (column 10, lines 33-48), which meets the limitation on a TV mode of operation and an ON-OFF control and wherein, if a user activates the ON-OFF control when the appliance is off, the appliance will come on in TV mode.

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Regarding claim 21, Gaughan discloses a web television (column 3, lines 54-55).

Gaughan discloses the web television can communicate with the Internet (column 4, lines 33-43). Gaughan discloses turning the webtv off (column 10, lines 49-56). Gaughan discloses the event is a user instruction to turn on the webtv, a message will be sent to tuner 48 to begin displaying video and audio on the webtv (column 10, lines 33-48), which meets the limitation on an appliance which can be turned on and off and has an TV mode of operation.

Gaughan fails to disclose the appliance coming on in a specified mode if, when the appliance is off, a user activates one of the specified mode controls. Kitao discloses the remote control has a key indicating various functions of electronic devices in addition to a selection key for selecting the electronic device (mode) (column 4, lines 65-column 5, line 6). Kitao discloses the remote control sends the function to the appropriate electronic device selected by the user (column 5, lines 7-12). Kitao discloses a control signal causing the device to power on (column 4, lines 22-31); thus the user selects the appropriate mode (i.e. TV) and then sends the control signal causing the device to power on in the specified mode, which meets the limitation on the appliance coming on in a specified mode if, when the appliance is off, a user activates one of the specified mode controls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gaughan to have the user turn on the device in a specified mode by pressing the appropriate control if the device is off as taught by Kitao in order to skip the step of turning the appliance on and subsequently selecting the mode, thereby saving time.

Regarding claims 22-24, Gaughan has met the limitations in claims 22-24 in the rejections of claims 1-3.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJC


CHRIS GRANT
PRIMARY EXAMINER